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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ZACHARIA, RAMSEY E

ART UNIT	PAPER NUMBER
	1773

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/897,014	SAIKI ET AL.	
	Examiner Ramsey Zacharia	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 March 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15, 19, 21-24 and 26 is/are pending in the application.
  - 4a) Of the above claim(s) 4-15 and 26 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 19 and 21-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 19 March 2003 is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>12</u> .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

2. Claims 4-15 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

### ***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 19 March 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

4. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

## **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

1. **Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front

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of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

***Claim Rejections - 35 USC § 102***

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Madonia et al. (U.S. Patent 4,546,022) as evidenced by Hatzikelis et al. (U.S. Patent 4,493,806).

Madonia et al. teach a decorative molding that may be used on automobile parts (column 1, lines 8-11). This reads on both an external part and a housing part since the molding is applied to the exterior of the automobile which is both an external part and a housing part. The molding comprises an interior made from recycled plastic and an outer layer having a thickness of up to 12 mils, i.e. about 0.305 mm (column 1, lines 19-41). The recycled plastic of the interior is obtained using the process of Hatzikelis et al., which involves pulverizing the scrap

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plastic (see Madonia et al., column 2, lines 8-14; and Hatzikelis et al. column 1, lines 5-17). The outer skin layer is pigmented (claim 4).

6. Claims 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ang et al. (U.S. Patent 5,851,624).

Ang et al. teach a multilayered molded article comprising a core layer and a skin layer surrounding the core layer (column 2, lines 13-38). The core and skin layers are made of plastic material (column 2, lines 13-17). The article may be used as an instrument panel cover containing air vents that is attached to a support structure by suitable fasteners (column 4, lines 10-17).

The skin layer surrounds the entire core layer (see Figure 3) and the fasteners attach the article to the support structure by means of the skin layer (see Figure 5, a tab and pin extending down from the lower skin layer of the article). Therefore, the area of the skin layer in contact with the suitable fasteners reads on the "mounting portion" recited in claim 21 since it meets all the structural limitations of the mounting portion, i.e. it is integral with and made of the same material as the skin layer.

Regarding claim 22, since the mounting portion of the skin layer is made of plastic it will inherently have some degree of elasticity since all polymers are visco-elastic materials.

***Claim Rejections - 35 USC § 102 / 103***

7. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Madonia et al. (U.S. Patent 4,546,022) as evidenced by Hatzikelis et al. (U.S. Patent 4,493,806).

Madonia et al. teach all the limitations of claim 3, as outlined above, except for requiring that the pulverized recycled plastic come from an external part, a housing part, or a constituent part of an office apparatus.

However, this is taken to be a product-by-process limitation, i.e. the process being pulverizing an external part, a housing part, or a constituent part of an office apparatus as opposed to the product which is just pulverized plastic. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and MPEP § 2113. In this case, the product of Madonia et al.

appears to be the same as that of the instant invention regardless of what shape the plastic was in prior to its being recycled and pulverized.

8. Claims 1-3 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ang et al. (U.S. Patent 5,851,624).

Ang et al. teach all the limitations of claims 1-3 and 24, as outlined above, except for requiring that the plastic of the core layer be pulverized recycled plastic. However, Ang et al. do teach that the core layer of their panel may be made of recycled panels (column 4, lines 37-49).

However, these limitations are taken to be product-by-process limitations (i.e. the process by which the plastic material is formed - pulverizing recycled material versus other types of recycled material or virgin material). For the reasons outlined above, the burden is on the application to demonstrate that the product-by-process limitations of claims 1-3 and 24 results in a product that differs from that of the prior art.

Regarding claim 3, the panel recycled to form the core layer reads on an external part (since it is a cover of an instrument panel) and a housing part (since it is houses instruments and air ducts).

***Claim Rejections - 35 USC § 103***

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Madonia et al. (U.S. Patent 4,546,022) as evidenced by Hatzikelis et al. (U.S. Patent 4,493,806), Jenkins et al. (U.S. Patent 4,448,608), and Perman et al. (U.S. Patent 5,508,060).

Madonia et al. as evidenced by Hatzikelis et al. teach all the limitations of claim 19, as outlined above, except for disclosing the lightness of the outer layer.

However, the lightness L of a molded polymer composition is a function of the color of the composition (see Tables 2 and 3 of Jenkins et al.; and column 14, lines 14-28 of Perman et al.) with  $L \rightarrow 100$  as the color approaches white and  $L \rightarrow 0$  as the color approaches black.

Madonia et al. teach the addition of a pigment to the skin layer (claim 4) but are silent as to the color of the pigment.

The examiner takes the position that it would have been obvious to one of ordinary skill in the art to use any pigment, including white pigments, depending on the desired color of the finished product.

Therefore, the inventions of claims 19 and 20 would have been obvious to one of ordinary skill in the art at the time the inventions were made.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ang et al. (U.S. Patent 5,851,624).

Ang et al. teach all the limitations of claim 23, as outlined above, except for specifying that the fastener is a screw.

However, Figure 5 of Ang et al. illustrates the use of an elongated, screw-like fastener. The examiner takes the position that it would have been obvious to use any elongated, screw-like fasteners, including a screw, particularly since Ang et al. broadly teach that the fastener may be any suitable fastener (see column 4, lines 10-14).

Therefore, the invention of claim 23 would have been obvious to one of ordinary skill in the art at the time the invention was made.

***Response to Arguments***

11. Applicant's arguments with respect to claims 21-24 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments with respect to claims 1-3 and 19 have been fully considered but they are not persuasive for the following reasons.

Regarding the rejection over Madonia et al. as evidenced by Hatzikelis et al., the applicants argue that the pulverized material of Hatzikelis et al. is cool prior to pulverizing as opposed to that of the instant invention that is not cooled prior to pulverizing. The applicants allege that cooling at any point prior to injection molding deteriorates the resin.

This is not persuasive for at least the following reasons. The claims as written do not require the resin to not be cooled prior to pulverization. Rather they are written with open language that permits resin formed by any type of pulverizing process. Moreover, the allegation that cooling at any point prior to injection molding leads to deterioration appears to be the opinion of the applicants and does not appear to be supported by anything of record.

Regarding claim 19, the applicants argue that the internal part of Madonia et al. is not colored and therefore does not affect the color of the final part regardless of the thickness of the skin. This is contrasted with the instant invention in which the influence of the interior on the appearance is controlled by the thickness of the skin.

This is not persuasive because the claim as written does not require the core layer to be colored but rather allows for the use of any core layer, even a core layer that is not colored. Madonia et al. explicitly teach a pigment in the skin layer and a thickness of the skin layer that reads on the claimed range. The only other physical limitation in the claim is the lightness of the skin layer. As evidenced by the teachings of Jenkins et al. and Perman et al., the lightness is a function of color. The choice of color of the article is a matter of taste and if one desired a white molding the lightness of the resulting skin layer would be not less than 55.

### *Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (703) 305-0503. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for non after-final correspondences and (703) 872-9311 for after-final correspondences.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ramsey Zacharia

Primary Examiner

Technology Center 1700

5/22/03